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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/187,385	11/06/1998	SVETOMIR N. MARKOVIC	07039/119001	2986

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EXAMINER

HOLLERAN, ANNE L

ART UNIT PAPER NUMBER

1642

DATE MAILED: 12/31/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/187,385

Applicant(s)

MARKOVIC, SVETOMIR N.

Examiner

Anne Holleran

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12,18,21,22,26,27 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12,18,21,22,26,27 and 30-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The amendment filed Oct. 15, 2002 is acknowledged. Claims 26 and 27 were amended. Claims 4-6, 28, 29, 39, and 40 were canceled.

2. Claims 8-12, 18, 21, 22, 26 and 27, 30-38 are pending and examined on the merits.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections Withdrawn:

4. The rejection of claims, 8, 18, 21, 22, 26, under 35 U.S.C. 102(e) as being anticipated by Tovey et al (U.S. Patent 5,997,858; issued Dec. 7, 1999; filed May 9, 1997) is withdrawn in view of the amendment.

5. The rejection of claims 9-12 under 35 U.S.C. 102(e) as being anticipated by Tovey et al in light of Brittenden et al (Brittenden, J. et al. Cancer, 77(7): 1226-1243, 1996, April) is withdrawn in view of the amendment.

6. The rejection of claims 9 and 40 under 35 U.S.C. 112, second paragraph, is withdrawn in view of the amendment.

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7. The rejection of claims 27-38 under 35 U.S.C. 103(a) as being unpatentable over Markovic et al[a] (Markovic, S.N. et al, Int. J. Cancer, 45: 788-794, 1990; IDS ref. "CH") in view of Edwards et al (Edwards, B.S. et al., Cancer Research, 44; 3135-3139, 1984; cited in the IDS) is withdrawn in view of the amendment.

New Grounds of Rejection:

8. Claims 8-12, 18, 21, 22, 26, 27, 30-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The basis for this rejection is that the amendment to claims 26 and 27, from which all the rest of the claims depend, introduces new matter into the specification.

Claims 26 and 27 recite a dosage range of "500,000 U/m² or less per day and at least about 250,000 U/m² per day". Applicant points to pages 5 and 11 for support for this amendment. However, pages 5 and 11 teach ranges that are not the same as "500,000 U/m² or less per day and at least about 250,000 U/m² per day". Furthermore, there is no teaching in the specification that would allow one to envision the dosage range of "500,000 U/m² or less per day and at least about 250,000 U/m² per day". Therefore, the amendment to claims 26 and 27 introduces new matter into the specification.

Conclusion

No claim is allowed.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the Office should be directed to Anne Holleran, Ph.D. whose telephone number is (703) 308-8892. Examiner Holleran can normally be reached Monday through Friday, 9:30 am to 2:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached at (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0196.



Anne L. Holleran
Patent Examiner
December 28, 2002



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